

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Parker et al.

Serial No.: 10/758,678

Group Art Unit: 1711

Filed: January 15, 2004

Examiner: Terressa M. Boykin

For: Process for Production of a Carboxylic Acid/Diol Mixture Suitable for Use  
in Polyester Production

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**Response Under 37 C.F.R. § 1.111**

This reply is in response to the Office Action mailed on December 8, 2004, and the period for response is set to expire on March 8, 2005. The following remarks are respectfully submitted. Reconsideration of the claims is respectfully requested.

**Issue I: Anticipation Rejection (35 U.S.C. §102)**

Claims 1-3 were rejected under 35 U.S.C. § 102(e) as being anticipated by US publication 20040176635. This rejection is respectfully traversed.

MPEP § 2131 states that “a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference”. MPEP sec. 2131 further states that “the elements must be arranged as required by the claim”.

US publication 2004017665 does not disclose every element as set forth in the claims in applicants' invention. For example, US publication 2004017665 does not disclose the limitation in the claims of "routing said water-wet carboxylic acid cake to a vapor seal zone." Description of this step can be found in applicants' disclosure starting on page 22, line 15. This limitation is found in every independent claim and thus in all dependant claims as well. Therefore, applicants' respectfully state the claims distinguish over the cited art and the 102(e) rejection should be withdrawn.

**Issue II: Obvious Double Patenting**

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) has been filed with this response. Therefore, applicants respectfully request that the provisional double patenting rejection be withdrawn.

**Issue III: Obviousness Rejection (35 U.S.C 103)**

Claims 46-51 were rejected under 35 U.S.C. 103(a) as being unpatentable over US publication 20040176635 in view of US Patent 6,307,099. This rejection is respectfully traversed. Applicants wish to respectfully point out to the examiner that US publication 20040176625 is disqualified as prior art.

It should be pointed out that the publication date is the critical date under 35 U.S.C. 103(a) rejections because MPEP 706.02(k) states that "Effective November 29, 1999, subject matter which was prior art under former 35 U.S.C 103 via 35 U.S.C 102(e) is now disqualified as prior art against the claimed invention if that subject matter

and the claimed invention 'were at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.'" US publication 20040176635 is assigned to Eastman Chemical Company as well as applicants' invention.

The publication date of US publication 20040176635 is 9/9/2004, and the filing date of applicants' invention is 1/15/2004. Therefore, U.S. publication 20040176635 is disqualified as prior art against applicants' invention. Applicants respectfully requested that the examiner withdraw the obviousness rejection for claims 46-51.

### Conclusion

The application is in condition for allowance. The Examiner is respectfully requested to reconsider the rejection(s), remove all rejections, and pass the application to issuance.

Respectfully submitted,



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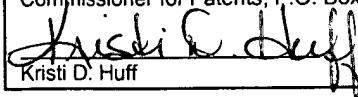
1/18/2005  
Date

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#### CERTIFICATE OF MAILING 37 CFR 1.8(a)

I hereby certify that this correspondence and any items identified as being included herewith is/are, on the date shown below, being deposited with the United States Postal service with sufficient postage as first class mail, in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

  
Kristi D. Huff

1/20/05  
Date